REMARKS

The Office Action of March 13, 2003 has been carefully reviewed. As explained in the following remarks, it is believed that the application is in condition for allowance.

To facilitate an understanding of the status of this application, a brief review of the history of this application is provided here. This application was filed as a continuation-in-part (CIP) of U.S. Application 09/224,237, which issued as U.S. Patent 6,201,549. The specification of this application differs from the parent '237 application mainly in the addition of a new description that starts at 19, line 9 of the specification and is illustrated in corresponding Figures 13-23 and 26. The new description is directed to the use of polygons rendered along a curved guideline of a brush stroke for applying a bitmap brush along the guideline. In the first Office Action, the Examiner rejected all pending claims based on the judicially created double patenting doctrine. Applicant did not agree with the obviousness-type double patenting rejection. Nevertheless, in the interest of expediting the allowance of the application, applicant submitted a terminal disclaimer to overcome the double patenting rejection. In the second Office Action to which this Amendment is responsive, however, the Examiner switched the ground of the rejections to the statutory double patenting under 35 U.S.C. § 101 and again rejected the pending claims.

Applicants respectfully but strongly traverse the double patenting rejections under 35 U.S.C. § 101. As explained in M.P.E.P. Section 804, the statutory double patenting is for preventing a patent applicant from obtaining two patents on the same invention. The ultimate question to be asked is: Is the same invention being claimed twice? In this case, the double patenting rejections under Section 101 were misapplied because the Office Action failed to properly establish the "sameness" of the claims of this application and the claims of applicant's US 6,201,549 patent.

Specifically, as to independent claims 1 and 19, the Office Action asserted that claim 25 of the '549 patent "teaches" claims 1 and 19, and further asserted:

> **It is apparent** that claim 25 of patent number **6,243,099** [sic] **discloses** determining a first polygon on the guideline, determining a first segment in the bitmap brush, and applying a first transformation to a bitmap image because the limitations explicitly teaches determining path points that are closest to the guide line path, determining and calculating an arc-length distance from an origin point on the path to the path point, and calculating the average of all looked-up pixel values. In other words, **a polygon of the present invention corresponds to the parametric form of a path.** As claimed in patent no. 6,201,549, column 12, line 49 discloses "defining in parametric form a path of a guide line" is a type of paragon. A parameter is any of a set of physical properties whose values determine the characteristics of something. Therefore, a polygon consists of parameters that form a particular shape. Thus "**parametric form a path" is a polygon.**

The Office Action's assertions are erroneous. First, the assertion regarding what claim 25 of the '549 patent (applicant assumes that the Office Action meant the '549 patent rather than the 6,243,099 patent) "apparently" teaches is clear erroneous on its face. Claim 25 does not even contain the word "polygon" or any equivalent term, and certainly does not recite "determining a polygon" or any other claim limitations relating to a polygon. Thus, the Office Action's assertion that claim 25 of the '549 patent "apparently" teaches the limitations of claims 1 and 19 is untenable. Such a bare assertion of "apparent teaching," without any explanation, is certainly insufficient for supporting a double-patenting rejection of either the statutory or obviousness type. If the Examiner should intend to maintain the same argument in the next Office Action, the Examiner is respectfully requested to explain, for purposes of setting a clear record for appeal, where and how claim 25 of the '549 patent teaches the polygon-related limitations of claim 1 and 19.

Also, the Office Action's conclusion that a "parametric form of a path of a guide line" **is** a "polygon" is clearly erroneous and rather shocking. First, that conclusion is plainly mathematically incorrect. For instance, a two-dimensional cubic Bezier curve, which is a commonly known parametrically defined curve, is certainly not a polygon. Moreover, The Office Action apparently

failed to properly consider the language of claims 1 and 19 of the present application and claim 25 of the '549 patent. Claims 1 and 19 call for "determining a first polygon **on** the guideline," while claim 25 calls for "defining in parametric form a path **of** a guide line." It is clear from the claim language, as well as the specification of the present application, that the polygon **on** the guide line in claims 1 and 19 is not the parametric path **of** the guide line in claim 25 of the '549 patent, regardless of whether a parametrically defined curve could be a polygon or not (which it is not).

Besides making the clearly incorrect assertions, the Office Action failed to apply the proper test for statutory double patenting. As explained in MPEP § 804 (II)(A), a reliable test for double patenting under 35 U.S.C. § 101 is whether a claim in the patent could be literally infringed without literally infringing a corresponding claim in the application. In this case, as described in page 13 of the specification, a familiar example of a parametric from of the path of a guideline is a two-dimensional cubic Bezier curve. Thus, a process of drawing a paint stroke may infringe claim 25 of the '549 patent if it includes, among other things, defining a path of a guideline in the form of a two-dimensional cubit Bezier curve. That process, however, may not infringe claims 1 and 19 of the present application if it does not determine a polygon on that guideline with the Bezier curve path. Accordingly, it is clear that claims 1 and 19 are not directed to the same subject matter, and the statutory double patent rejection is improper. Since the statutory double patenting rejection with respect to claims 1 and 19 is invalid, the dependent claims of claim 1 and 19 should also be allowable.

The Office Action also rejected independent claim 38 on the ground of double patenting rejection under 35 U.S.C. § 101. Specifically, the Office Action asserted:

> Claim 38 of the application recite the scope of invention of claims 3, 6, 8, and 10 in the patent number 6,201,549. **It is apparent** that claims 3, 6, 8, 10, and 19 of patent number **6,243,099** [sic] discloses a linearization module, a polygon generating module, and a mapping module because the limitations explicitly teaches the adding step, determining a plurality of normal points along the instantaneous normal lying

within the guide line, and mapping a pixel selected from the bitmap brush to the point.

This assertion of "apparent teaching," like the similar assertion regarding the "apparent teaching" in claim 25 of the '549 with respect to claims 1 and 19, is clearly erroneous on its face. Claims 3, 6, 8, 10, and 19 of the '549 patent (rather than the 6,243,099 patent) clearly do not recite generating a plurality of line segments approximating a curved line, detecting a sharp corner, or identifying corners of a polygon corresponding to one of the line segments, etc. Again, such a bare assertion of "apparent teaching" is insufficient for supporting a double-patenting rejection of either type, and the Examiner is respectfully requested to explain, for purposes of setting a clear record for appeal, where and how those claims of the '549 patent teach the various limitations of claim 38. Moreover, such an "apparent teaching" argument is simply not a proper test for determining statutory double patenting. Accordingly, claim 38 should be allowable. Claim 39 depends from claim 38 and should also be allowable.

In summary, since the arguments given in the Office Action for supporting the statutory double patenting rejection under 35 U.S.C. § 101 are clearly flawed, the rejections cannot stand and should be withdrawn, and the application should be allowed.

Lastly, applicant submitted an Information Disclosure Statement on December 13, 2001. Neither of the two Office Actions in this case has indicated that the references in the IDS have been considered by the Examiner. Accordingly, the Examiner is respectfully requested to indicate that those references have been considered by initialing the list of references in the IDS.

Conclusion:

In view of the foregoing, this application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue.

In re Application of: John Bronskill
Serial Number: 09/602,044

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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